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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,775	03/10/2006	Aarto Paren	0696-0219PUS1	1488
2292 7590 05/20/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER CALANDRA, ANTHONY J				
ART UNIT		PAPER NUMBER		
1791				
NOTIFICATION DATE		DELIVERY MODE		
05/20/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/541,775

Applicant(s)

PAREN ET AL.

Examiner

ANTHONY J. CALANDRA

Art Unit

1791

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 May 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 13-15 and 17-32.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/AJC/

/Eric Hug/
Primary Examiner, Art Unit 1791

Continuation of 3. NOTE: Applicant submitted amendments which require further consideration of the references, including limiting the polymer composition by using the language "consisting of", and changing the time between step b to 'essentially immediately' after step b.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that Nishino does not disclose nor suggest solving the precipitation problem by providing an acidic aqueous stabilizing solution. Nishino at least teaches a pH of 6 which is an acidic pH and abuts with the instant claimed range of at most 6. Nishino even claims a pH of 6 as a more preferred embodiment. Therefore the claimed range of 'at most 6' which includes 6 is certainly obvious over a more preferred range of 6-8. This leaves the dependent claim 17 of at most a pH of 5. A person of ordinary skill in the art would conclude that both a pH of 5 would be successful as a pH of 5 and 6 are both weakly acidic pHs. A pH of 6 is described as a more preferred pH. There is no unexpected result between a pH of 6 and a pH of 5 shown by the applicant. Applicant has argued the turbidity of a pH of 6.4 but not the turbidity of the pH of 6 which is claimed by the applicant and a more preferred embodiment of Nishino.

Applicant argues that because EDTMP was unsatisfactory it would dissuade the person of ordinary skill in the art from selecting another phosphonate chelant from HYDE. Applicant argues that it would not be obvious to substitute another phosphonate chelant (which does not contain nitrogen) for a phosphonate chelant EDTMP because it performed poorly. The chelant EDTMP is shown poorly in experiments 12 and 14. In experiment 12 the EDTMP is combined with a SPA1 polymer and performs better than DTPA of experiment 6 combined with SPA1 polymer. DTPA is shown effective in example 1-7, and 9-17. In experiment 14 while EDTMPA is combined with PHAS, it is combined with SPA4, not the SPA1 or SPA2 of example 1-17. Therefore it cannot be concluded that EDTMP is poorly performing since no experiment was conducted with EDTMP, SPA1, and PHAS together. The comparison of experiments 12 and 6 may even lead the person of ordinary skill to conclude that such an experiment may provide better results.

Finally applicant argues that Nishino certainly concludes that nitrogen is an essential feature of the invention. Removing metals from the solution by way of chelants is the critical feature of the invention [column 2 lines 25-30]. Metal ions degrade peroxide in pulp bleaching systems. The applicant has not shown why a person of ordinary skill in the art would find that the metal ions must be removed by a nitrogen containing chelant compared to a non-nitrogen containing chelant. Both nitrogen containing chelants and non-nitrogen containing chelants are intended for the same purpose, removing metals in pulp bleaching.

Additionally applicant's argument of requiring nitrogen in the chelant conflicts with the applicant's argument that EDTMP is ineffective. While EDTMP is a phosphonic acid it also contains nitrogen. If it is allegedly ineffective as the applicant argues, then a chelant which contains nitrogen is also ineffective. Therefore nitrogen cannot be a critical feature based on the applicant's arguments.